

**REMARKS**

Reconsideration is respectfully requested.

Claims 1 through 23 remain in this application. No claims have been cancelled or withdrawn. Claims 24 through 26 have been added.

**Parts 1 and 2 of the Office Action**

Claims 1 through 3, 5 through 13, and 15 through 18 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Sands (U.S. Pat. No. 6,631,188).

Claims 4, 14, 19, and 22 through 23 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Sands (U.S. Pat. No. 6,631,188) in view of Todd (U.S. Patent No. 6,760,423).

Claim 1 requires, in part, "scheduling means, disposed within the first device, for enabling scheduling by the user of a call-back based on the identifying caller information identified by said identifying means"

It is contended in the final Office Action, as in the earlier Actions, that Sands teaches a caller ID unit for identifying caller information associated with an incoming call (citing Sands, Figure 5) and scheduling means for a call-back (citing Sands, Abstract).

It is further asserted in the final rejection that it is "unclear" whether the caller ID unit is incorporated into the telephone 12. However, it is submitted that, in contrast to the characterization of the Sands teaching in the rejection of the Office Action, the Sands patent actually clearly teaches one of ordinary skill in the art that the caller ID unit of the Sands system is separate from the telephone, and thus the teaching of Sands is not "unclear" on this point. For example, Figures 1 and 2 of the Sands patent clearly and unambiguously show the "caller ID unit" 22 (in Figure 1) and 60 (in Figure

2) as a separate and distinct element from the telephone 20 (in Figure 1) and 52 (in Figure 5). It is submitted that there is a clear delineation between these elements in the drawings figures that one of ordinary skill in the art would recognize are distinct elements. (Also note that the telephone 20 and 52 are depicted with a drawing of a telephone, and not simply as another block in the block diagram of these figures, which further leads one of ordinary skill in the art to understand that telephone 20 and 52 is not just simply another element of the overall invention, but a distinct environmental element.)

Further, Sands states at col. 1, lines 56 through 59 that (emphasis added):

Dynamic call waiting based on the caller's ID is carried out under the control of a microprocessor located either in a subscriber's caller ID unit or at a telephone network processing center.

Thus, the Sands patent describes the functionality being carried out by a microprocessor in two locations—neither being in the user's telephone.

Also, Sands states at col. 2, lines 55 through 58:

Caller ID unit 22 is a remote device located with the first telephone terminal 12, commonly referred to as customer premises equipment (CPE).

Thus, the caller ID unit of Sands is described as being used with “customer premises equipment”, and not as part of any customer premises equipment or telephone terminal. Still further, Sands describes the caller ID unit at col. 3, lines 7 through 53 as having a number of elements (e.g., speaker) that duplicate those found in a telephone, and describe features (e.g., voice recognition) that are not typically found in a conventional telephone. Thus, it is submitted that these teachings of the Sands patent cannot be ignored so that it can be said that sands is “unclear” as to whether the caller ID unit is part of a telephone, as the question is what would one of ordinary skill in the art understand from the art.

It is further contended in the Office Action that it would have been obvious to one of ordinary skill in the art to incorporate the caller ID unit into the phone 12 as such would only entail putting two separate devices used together and incorporating them into one device.

Contrary to the Office Action, it is respectfully submitted that it would not have been obvious to one of ordinary skill in the art to combine the dynamic call waiting phone system of Sands into a telephone. Sands is directed to a telephone system comprising a dynamic call waiting system based on caller ID in which calls are routed based on the calling number, and are, for example, routed to voicemail, a forwarding number or scheduled for a call back (Sands, Abstract).

It is contended in the Response to Arguments portion of the final Office Action that “[t]he combination of a caller ID unit and a telephone are well known in the art and as stated to combine such would have been obvious to one of ordinary skill”. However, Sands describes a system whose functions go beyond merely providing caller ID information to the user of the telephone, and includes a number of functions in addition to conventional “caller ID”. Specifically, the disclosed dynamic call waiting system functions to route calls while a user is using a telephone. It is submitted Sands fails to provide any enabling disclosure which would allow one of ordinary skill in the art to modify a telephone so that the telephone would function as a telephone for carrying on a telephone conversation as well as, to function to re-route incoming telephone calls in accordance with the disclosed dynamic call waiting system which is incorporated in a telephone network, i.e., dynamic call waiting system 10, remote from a telephone connected to the system. In order for a reference to be anticipatory, the reference must be enabling, i.e., the reference must teach one of ordinary skill in the art how to make or carry out the claimed invention without undue experimentation (see Elan Pharmaceuticals, Inc. v. Mayo Foundation, 64 USPQ2d 1292 (Fed. Cir. 2002)). Since Sands fails to

enable one of ordinary skill in the art to produce the present invention as claimed in claim 1 which recites, *inter alia*, scheduling means disposed in a first device which enables one to speak to an initiator of an incoming call, and schedule, by the user, a call back based on an identified caller information, claim 1 is not obvious in view of Sands.

Claim 10 requires, in part “providing the caller information associated with the incoming telephone call through the first device to a recipient of the incoming call” and “enabling the recipient of the incoming call to optionally select, *after receiving the incoming call*, initiation of automatic scheduling of a call-back for the incoming telephone call, using the first device, *based on the caller information provided to the recipient*”. Further, claim 15 requires, in part, “means for presenting the identifying information to a recipient of the incoming communication” and “means for enabling the recipient of the incoming communication to optionally select, *after receiving the incoming communication and presentation of the identifying information*, initiation of automatic scheduling of a response to the incoming communication *based on information identified by said identifying means*”. Claim 22 requires “wherein the scheduling means enables a user of the portable device, after receiving the incoming call, to, at the option of the user, automatically schedule a call-back”. Claim 23 requires “wherein the scheduling means enables a user of the first device, to, at the option of the user and based on a selection by the user after receiving the incoming call, automatically schedule a call-back”.

In contrast to the present invention in which, after receiving a telephone call, the user can select to schedule a call back, Sands discloses a call waiting system in which a scheduled call back is stored, i.e., selected, prior to receiving a telephone call. In other words, a user of the Sands system can select to activate a call back feature prior to receiving a telephone call but not after. Further, in Sands, it is the dynamic caller ID system, illustrated, for example by step 160, which determines if a call back

service is to be used when the called party is unavailable. If so, the service provider, at step 160, schedules a call back to the called party when the called parties line is no longer busy (Sands, col. 6, lines 46-53 and Figure 6). Therefore, it is the phone system in Sands which does the initiation of automatic call back based on a previous instruction of a user prior to a call being initiated.

Conversely, in the present invention as claimed in claim 23, the user makes the selection to schedule the call back after receiving the phone call, not prior to receiving the phone call. For the foregoing reasons it is respectfully submitted that, Sands does not teach or suggest claim 23.

With regard to claims 10 through 13 and 15 through 18 and 23, as well as added claims 24 through 26, the claims require that the recipient of an incoming communication optionally selects, after receiving an incoming call, to initiate automatic scheduling of a response. As discussed above with regard to claim 23, Sands fails to teach or suggest an arrangement wherein a recipient, after receiving an incoming communication, selects and initiates automatic scheduling of a response. Instead, Sands merely teaches that a recipient, prior to receiving an incoming call, sets up an automatic call back feature. Nowhere does Sands teach or suggest a user selecting, after receiving an incoming call, initiation of automatic scheduling as claimed. Moreover, it is respectfully submitted that Sands does not teach or suggest that a recipient of a call would or could make any determination with respect to, or provide initiation of, automatic scheduling of a call back by the recipient in response to an incoming call. Sands merely teaches an automated system which may schedule a call back if a recipient, prior to receiving an incoming call, has configured the system accordingly.

It is submitted that the aforescribed distinction between the requirements of the claims and the teaching of Sands is significant, as the

Sands system is operative only with respect to phone numbers previously entered in the database and previously indicated as being

There is no specific identification of what portion of the Todd patent is believed to disclose this feature of the claimed invention, and it is contended in the "Response to Arguments" portion of the final Office Action that, the function of Todd "of course could be done after a call is completed". However, what "could" be done, or what is possible, is not equivalent to what is taught to one of ordinary skill in the art by Todd. Further, when one of ordinary skill in the art considers what is taught in the Sands patent leads one of ordinary skill in the art to believe that the determination of whether a call is to be scheduled for a call back is done before the call is received, by entering the number into the database. This clearly leads one of ordinary skill in the art to believe that the determination of the handling of the call is made well before the call is received, and most likely would suggest to one of ordinary skill in the art that the determination must be made before the call is received.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Sands and Todd set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1, 10, and 15. Further, the claims that depend from these claims also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §103(a) rejection of claims 1 through 23 is therefore respectfully requested.

Appln. No. 09/966,533  
Amendment dated January 17, 2006  
Reply to Office Action mailed October 19, 2005

**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

GATEWAY, INC.

By 

Date: JAN. 17, 2006

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